REMARKS

Examiner's attention is drawn to the fact that a Preliminary Amendment was filed concurrently with the National Stage Application on August 30, 2001. In this Preliminary Amendment, claims 16, 19, and 22 were cancelled.

The Examiner has restricted the claims into the following Groups:

> Groups 1-22, claim(s) s 1-2, 15, 16 drawn to a first product and first method of use of that product: a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate group.
>
> Groups 23-44, claim(s) 3-8, 10, 11, drawn to a second product and a first method of use of that product: a polynucleotide of ONE of SEQ ID NO: 23-44, each SEQ ID NO: is a separate group.
>
> Groups 45-67, claim 4 drawn to a third product: an antibody that binds a polypeptide of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group.
>
> Groups 68-90, claims 12-14, drawn to a second method of use of the polynucleotide of ONE of SEQ ID NO: 23-44, Each SEQ ID NO: is a separate Group.
>
> Groups 91-113, claim 17 drawn to a method of screening for an agonist using a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group
>
> Groups 114- 136, claim 18 drawn to an agonist of a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group
>
> Groups 137-159, claim 19, drawn to a method of treatment with an agonist of a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group.
>
> Groups 160-182, claim 20 drawn to a method of screening for an antagonist using a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group.
>
> Groups 183-205, claim 21 drawn to an antagonist of polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group

> Groups 206-228, claim 22, drawn to a method of treatment with an antagonist of a polypeptide of ONE of SEQ ID NO: 1-22, each SEQ ID NO: is a separate Group.
>
> Groups 229-251 , claim 23, drawn to a method of screening of a compound that alters expression of a nucleotide of ONE of SEQ ID NO: 23-44, EACH SEQ ID NO: is a separate Group.

Applicants provisionally elect, ***with traverse***, Group 35, claims 3-8, 10 and 11, drawn to a polynucleotide of SEQ ID NO: 35, for prosecution in the present application.

Applicants traverse the restriction requirement because the unity of invention standard must be applied in national stage applications. Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides:

> ... [W]hen the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111....
>
> In applying PCT Rule 13.2 to ... national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2....

Id at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

> Examiners are reminded that unity of invention (not restriction) practice is applicable ... in national stage (filed under 35 U.S.C. 371) applications.

Id at page 1800-149, column 1.

Indeed, according to Example 17, Part 2 of Annex B to the PCT Administrative Instructions, the Examiner is obliged to find that "[T]he protein and the DNA sequence

exhibit corresponding special technical features" and that, therefore, there is no lack of unity between claims directed to a protein "X" and the DNA sequence that encodes protein "X."

Thus, in the present case, unity of invention does exist at least as between claims 3-8, 10 and 11 and claims 1-2, 15 and 16, covering the polynucleotide depicted in SEQ ID NO: 35 and the polypeptide depicted in SEQ ID NO: 13, which encodes that polypeptide.

Applicants further traverse the restriction requirement on the grounds that the search and examination of at least Groups 35 and 13 (Group 35 is drawn to a polynucleotide of SEQ ID NO: 35 and Group 13, claims 1-2, 15 and 16, is drawn to a polypeptide of SEQ ID NO: 13) is not unduly burdensome. According to MPEP section 803 "if a search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." As the polynucleotides of Group 35 encode the polypeptides of Group 13, Applicants suggest examination of at least Groups 35 and 13 can be made without serious burden.

Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement at least as to claims 3-8, 10 and 11 (drawn to SEQ ID NO: 35) and claims 1-2, 15 and 16 (drawn to SEQ ID NO: 13), and examine those claims in a single application.

CONCLUSION

The pending claims are in condition for allowance. An early notice to this effect is earnestly solicited. Should there be any questions concerning this application, Examiner Zeman is invited to contact the undersigned at the number listed below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By _____

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